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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,283	08/01/2003	Jay K. Sato	AVERY 66452	3347

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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/633,283	Applicant(s) SATO ET AL.	
	Examiner Mark T Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 11-15, 17-19, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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1. Claim 1 recites the limitations: "the outer surface" in lines 13 and 14; and "the shield /frame assembly" in line 14. There is insufficient antecedent basis for these limitations in the claim.
2. Claim 4 recites the limitations: "the ends" in line 1; and "the top-to-bottom extent" in line 2. There is insufficient antecedent basis for these limitations in the claim.
3. Claim 5 recites the limitations: "the frames" in line 1; "the areas" in line 2; and "the frame side" in line 3. There is insufficient antecedent basis for these limitations in the claim.
4. Claim 7 recites the limitations: "the pivot line" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 8 recites the limitation "the frames" in line 1. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 9 recites the limitation "the pivot line" in line 1. There is insufficient antecedent basis for this limitation in the claim.
7. Claims 11 and 17 recites the limitations: "the ends" in line 1; "the length" in line 2; "the top-to-bottom extent" in line 2. There is insufficient antecedent basis for this limitation in the claim.
8. Claims 12 and 18 recites the limitations: "the frames" in line 1; "the areas" and "the frames" in line 2; and "the frame side" in line 3. There is insufficient antecedent basis for these limitations in the claim.

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9. Claim 13 and 19 recites the limitation "the frames" in line 1. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 14 recites the limitations: "the outer surface" in lines 13 and 14; and "the shield/frame assembly" in line 14; "the ends" in line 19; "the top-to-bottom extent" in line 20; "the frames" and "the frame side" in line 22 and 27; the pivot line" in line 23 and 24; "the shield side" in line 25. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 21 recites the limitation "the top" in line 2. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 22 recites the limitation "the outermost extent" and "the frames" in line 2; and "the plane" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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13. Claims 1, 2, 4, 6, and 7-9, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (6,168,338).

Young discloses in Fig. 1-10, a wrap-around notebook comprising; a front cover (12), a rear cover (14); a spine (16); a ring assembly having two elongated frame members (20 and 22) made of any desirable material and pivotally coupled together; a shield member (18); a first set of half rings (24) secured to one of the frame members (22), a second mating set of half ring members (26) mounted on the other frame member (20); a hinge plate (68) pivotally (by hinge pin (74)) to the shield member (18); wherein the shield is pivoted to the hinge plate by curls extending from the shield and mating curls formed along the hinge plate (as seen in Fig. 1); wherein the ends 28 and 38) of the shield are curved (seen in Fig. 2), and the length of the shield is less than the top-to-bottom extent of the covers (see Fig. 1); wherein the ring assembly is mounted with the pivot line (at hinge pin (74)) between the hinge plate and the shield (18) and adjacent a pivot line (hinge line between back cover and spine) with the shield side facing (partly) toward the front cover (see Fig. 2)

However, Young does not disclose: wherein the hinge plate is substantially aligned with an outer surface of the shield/frame assembly when the hinge plate is oriented parallel to the plane of the shield; wherein two hinge plate are provided; wherein the frame members are plated for corrosion protection.

In regards to **Claim 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to align the hinge plate and shield frame assembly in any

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direction or orientation, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to align the hinge plate and shield/frame assembly in any orientation, since applicant has not disclosed the criticality of the hinge plate and shield/frame assembly being aligned in a particular orientation, and invention would function equally as well if aligned in any manner.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many hinge plates as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to include as many hinge plates as desired since applicant has not disclosed the criticality of having more than one hinge plate and invention would function equally as well with any desirable number.

In regards to **Claim 8**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the frame members in any desirable material or covering, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. Therefore, it would have been obvious to construct the frame member in any material since invention would function equally as well with any material which prevent corrosion and gives an aesthetic appeal.

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Allowable Subject Matter

14. Claims 3, 5, 11-13, 17-22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15. Claim 14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

16. Claims 10 and 16 are allowed.

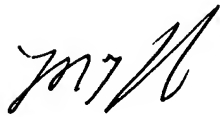
Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Gusack, Venegas, Kapur et al, and Im disclose similar wrap-around notebooks.

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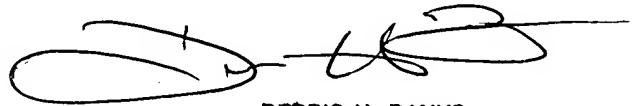
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Derris Banks, can be reached on (571) 272-4419. The fax number for TC 3700 is (703)-872-9306.



MTH

March 18, 2005



DERRIS H. BANKS
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